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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
RONESL VICKERY M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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***Attachment to Advisory Action***

1. The terminal disclaimer filed on 11/25/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. application serial nos. 10/524,472 and 10/524,366 has been reviewed and is accepted. The terminal disclaimer has been recorded and the obviousness-type double patenting rejections over these applications have been withdrawn. It is noted that applicant is required as detailed in paragraphs 9 and 11 of Office action mailed on 3/17/2008 to supply a statement common ownership at the time of invention is required to preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g). It is suggested that applicant submit a statement such as, "Application X and Application Y were, at the time the invention of Application X was made, owned by Company Z." See MPEP § 706.02(l)(2).

2. Applicant's response filed 11/25/2008 has been fully considered but is not persuasive. Specifically, applicant argues (A) that "structurally modified" is a term well known in the term; (B) that Bock does not disclose "structurally modified" pyrogenic silica; and (C) that the instant invention provides for unexpectedly improved scratch resistance

With respect to argument (A), applicant cites Meyer '531, Meyer '642, Nargiello, and Hartmann as evidence, however, these are not convincing given that Meyer '531, Meyer '642, Nargiello, and Hartmann are all owned by the present assignee and therefore cannot serve to establish the ordinary and customary term of the art. There is no indication on the record that establishes that any person of ordinary skill outside of the Degussa family refers to "structurally

modified” as silica that is subject to ball milling. Evidence to support the examiner’s position is found in Mort et al (US 4,613,556) which teaches that silicon oxide can be structurally modified by exposure to energetic radiation (col. 12, lines 10-12) or in Sands et al (US 5,001,183) which teaches structuring silica by acidifying silica (col. 4, lines 8-16). Furthermore, the specification does not elaborate on what type of structural modification is being performed, i.e., is it chemical or physical?

With respect to argument (B), while the instant claims recite “structurally modified” silica, it is not made clear how “structurally modified” silica is different from the silica taught by Bock or why the pyrogenic silica of Bock is not structurally modified. Bock teaches that the silica is prepared by jet dispersion, and it is the examiner’s position that this process causes the silica to be “structurally modified” due to the deagglomeration of silica agglomerates. Furthermore, the specification does not elaborate on how the instant silica is “structurally modified.”

With respect to argument (C), the data in the specification cannot establish unexpected results for several reasons. First, it has not been established how “structurally modified” silica differentiates itself from the silica of Bock. See discussion above.

Second, evidence of secondary considerations is irrelevant to 35 USC 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Third, the data is not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed.

Cir. 1983). Specifically, the type of polymer composition in the lacquer (i.e., acrylic copolymer) is not commensurate in scope with the scope of the claims. Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978). Furthermore, the relative amounts binder and silica are not reasonably commensurate in scope. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d).

1/6/2009  
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